

REMARKS

In the Official Action, the Examiner provided an understanding of the phrase "regulated by JIS--", noted that the certified copies of the priority documents had not been filed, raised an objection with respect to claims 7 and 8 and set forth a variety of rejections for claims 1-16. Independent claim 17 and claim 18 depending therefrom were allowed in the Official Action.

The instant Amendment makes a number of editorial revisions throughout the specification and responds to the various points raised in the Official Action. In this latter respect, applicants first note that the Examiner's understanding of the phrase which includes the term "JIS" is correct and that applicants have provided certified copies of all of the Japanese priority documents for which acknowledgment is now respectfully requested. Turning to the remaining issues raised in the Action, claims 2-16 have been canceled without prejudice or disclaimer thereby mooting the rejection as it applies to claims 2-15 and the objection in claims 7 and 8. Dependent claim 16 has been presented in independent form as new claim 19 and the patentability of such claim will be explained below.

With respect to the embodiment of the present invention defined in claim 1, such claim has now been amended to confirm that the defined alkali etching treatment is conducted after the claimed draining treatment consistent with the description in the specification such as in the passage beginning with the last paragraph on page 12 of the specification. From this passage, which extends to page 14, line 11, those of ordinary skill in the art can understand that this defined aspect of the invention can provide improved

development performance than would otherwise be obtained due to the photosensitive layer provided on convex portions of the surface of the support.

Applicants respectfully submit that the embodiment of the present invention defined in amended claim 1 is patentable over the documents identified in Section 12 of the Action. In particular, Sawada et al., U.S. Patent No. 5,779,824, does not recognize the challenges addressed by this embodiment of the present invention which are explained in the specification such as in the paragraph bridging pages 9 and 10. Moreover, the type of alkali etching described in Sawada et al. is a pretreatment commonly performed prior to the graining treatment for the purpose of degreasing. This understanding is confirmed by the description provided in Sawada et al. such as in the passage beginning at column 9, line 11. The defined alkali etching treatment is also different from the desmutting treatment using an alkaline solution disclosed in Sawada et al. at column 9, lines 54-61.

As to the Examiner's reliance on Urano et al., U.S. Patent No. 6,200,727, the patent does describe a photosensitive composition coated to a thickness of 0.3 to 7 μm to form a positive photosensitive lithographic printing plate. However, the patent does not describe or suggest the specific recitation in claim 1 that the average thickness of the thinnest 10% of the photosensitive layer on convex portions of the surface of the support is in the range of 0.2 to 2 μm . Hence, claim 1 is clearly patentable over the proposed combination of Urano et al. and Sawada et al.

Turning to the rejection of claim 16 (which again has been presented in independent form as new claim 19), applicants first note that the stated rejection in section 13 of the Official Action is legally incorrect. That is, the Examiner has relied on the combination of

Urano et al., with Nishino et al., U.S. Patent No. 6,264,821. Nishino et al. issued on July 24, 2001 which is subsequent to the U.S. filing date of the present application which is May 15, 2001. Thus, Nishino et al. can only be relied on as "prior art" under 35 U.S.C. § 102(e). However, the present application is entitled to the provisions of 35 U.S.C. § 103(c) and since the inventors were under an obligation to assign the invention to the same assignee at the time the invention was made, the provisions of 35 U.S.C. § 103(c) disqualify Nishino et al. as "prior art" in the context of a rejection under 35 U.S.C. § 103(a).

Applicants note that this provision of 35 U.S.C. § 103(c) does not apply to the published Japanese priority documents of Nishino et al. However, even considering that such documents constitute "prior art" against the embodiment defined in new claim 19, it still would not result in this embodiment of the invention and certainly would not provide an appreciation of the advantages which can be obtained therefrom, such as set forth in the first paragraph on page 11 of the specification, the paragraph beginning at page 21, line 3 and the discussion provided on page 23, lines 1-23. In this last passage, it will be noted that the fourth aspect refers to this claimed aspect of the invention in view of the referenced 85-degree surface gloss.

For all of the reasons set forth above, applicants respectfully submit that all the issues raised in the Official Action have been fully met and that claims 1 and 17-19 are patentable. Accordingly, reconsideration and allowance of the present application are respectfully requested.

Should the Examiner wish to discuss any aspect of the present application, she is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

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